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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

LS-006CV

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on 05/27/2010

Signature

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name

Tammy S. Moynihan

Application Number

10/772,185

Filed

02/04/2004

First Named Inventor

Jude S. Sauer

Art Unit

3734

Examiner

Victor X. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

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Registration number 38,539☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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May 27, 2010

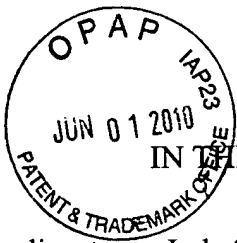
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT EXAMINING OPERATION

Applicant: Jude S. Sauer  
Serial No.: 10/772,185 Confirmation No: 4686  
Filed: 02/04/2004  
For: INSTRUMENT FOR GUIDING THE SURGICAL CUTTING OF  
TISSUE AND METHOD OF USE  
Examiner: Victor X. Nguyen Art Unit: 3734  
Atty. Docket: LS-006CV

APPLICANT'S REMARKS  
FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1) Claims 1-10, 15-18 and 20-31 were rejected as being anticipated by U.S. Patent No. 5,817,013 (Ginn et al.) "Ginn".

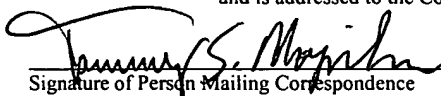
a) First, withdrawal of this anticipation rejection of Claims 4, 5, 8, 9, 20, 22, 24, and 29 is requested as such claims describe a blade shuttle, but Ginn has not blade shuttle. In fact, the Examiner agrees with Applicant since he states on page 5 of the 1/27/10 Office Action that Ginn has no blade shuttle. Since the Examiner has not properly shown how each and every element of Claims 4, 5, 8, 9, 20, 22, 24, and 29 is found within the single reference of Ginn, the anticipation rejection of these claims is in error.

b) Second, Claim 1 describes an instrument for cutting tissue guided along a guide wire having a shaft extending to a distal end with an opening to outside of the instrument, a guide tube with an outer tubular surface where the guide tube extends from such shaft through that shaft opening, a path through at least an opening extending through guide tube for extending a guide wire, and means for longitudinally cutting tissue guided along the outer tubular surface of the

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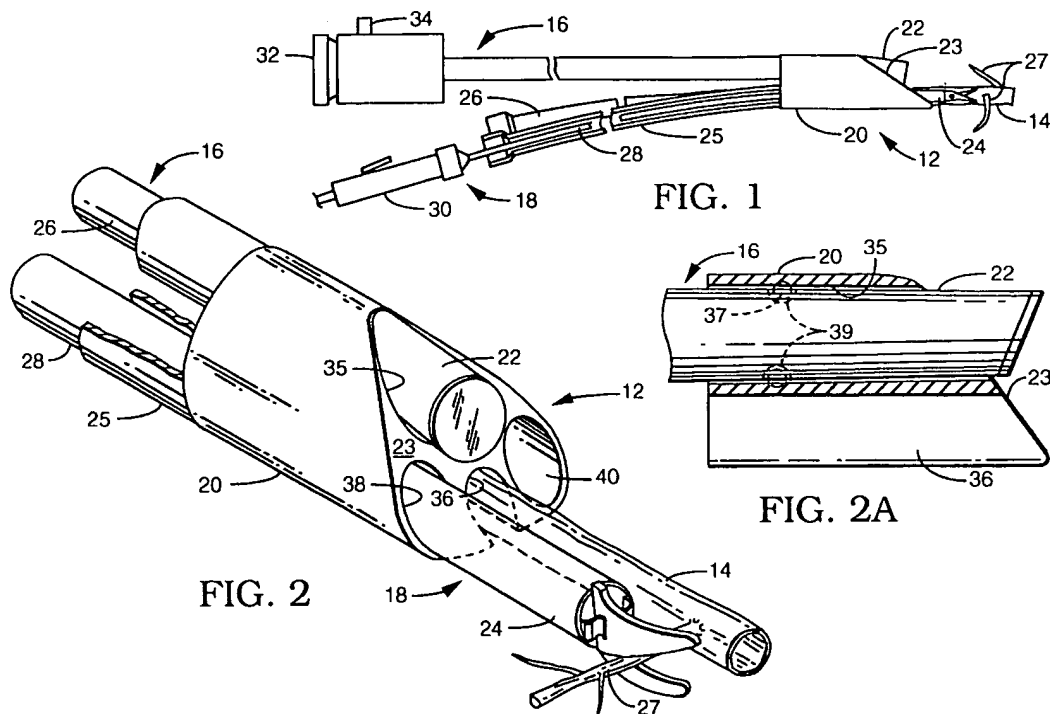
  
Signature of Person Mailing Correspondence

Tammy S. Moynihan

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guide tube through the shaft's opening. Such means has a blade extendable and retractable through the shaft's opening to cut tissue when present outside of the instrument.

To explain the difference between Ginn and Claim 1, FIGS. 1, 2, and 2A of Ginn are copied below:



It is the Examiner's position that element 16 of Ginn is the Claim 1 shaft, member 20 is the Claim 1 guide tube, and scissors 18 is the Claim 1 means for cutting tissue. FIG. 1 of Ginn shows element 16 as being the endoscope (see also Ginn col. 3, line 7), and FIGS. 2 and 2A of Ginn shows the endoscope 16 extending through a lumen 35 of a member 20 (see Ginn col. 3, lines 40-47). FIG. 2 also shows the end of the endoscope 16 is closed by virtue of the stippling shown. The Examiner has thus erred in that a closed shaft cannot provide the Claim 1 opening at its distal end to outside of the instrument.

c) Third, even if one considered member 20 as the Claim 1 guide tube as contended by the Examiner, the Examiner has erred in this view that scissors 18 represent the Claim 1 means for cutting tissue. This error is evident in FIG. 2 where scissors 18 extend along an interior surface (of lumen 38) of Ginn's member 20, while in contrast Claim 1 describes means for longitudinally cutting tissue is guided along the outer tubular surface of the guide tube through the shaft's opening.

d) Fourth, Claim 1 describes means for cutting tissue guided through an opening of the shaft. As evident from the above FIGS. 1 and 2 of Ginn, scissors 18 and endoscope 16 extend through different lumens 35 and 38. Thus scissors 18 cannot extend through the endoscope 16 which would be necessary if the endoscope 16 were the Claim 1 shaft as contended by the Examiner. Moreover, as shown in FIG. 1 of Ginn, Ginn relies on two different shafts one for endoscope 16 and the other for its scissors 18. Thus, the Examiner has erred in that the Ginn's endoscope 16 cannot represent the Claim 1 shaft having an opening through which any means for cutting tissue is guided. Such cannot even be suggested, especially where FIG. 1 of Ginn shows the opposite of that contended by the Examiner.

e) Fifth, Claim 1 describes "a path through at least said opening of said guide tube for extending a guide wire". Member 20 has a vein 14 along 36, but this is not comparable to a guide wire.

For the above reasons, Ginn fails to show each and every element of Claim 1. Thus, Claim 1 and those rejected dependent upon at least Claim 1 cannot be anticipated by Ginn, and Claim 1 and its dependent Claims should be allowable.

2) In regards to anticipation rejection of Claims 25, there is no member in Ginn which guides movement of a blade out any end of a shaft. There is no shaft out of which any blade is moveable, rather the scissors 18 contended by the Examiner to be the Claim 25 blade extends apart from the endoscope 16 contended by the Examiner to be the Claim 25 shaft. This is clearly evident from above FIG. 1 of Ginn which relies on two different shafts one for endoscope 16 and the other for scissors 18. Thus, Claim 25 and those rejected dependent upon at least Claim 25 cannot be anticipated by Ginn.

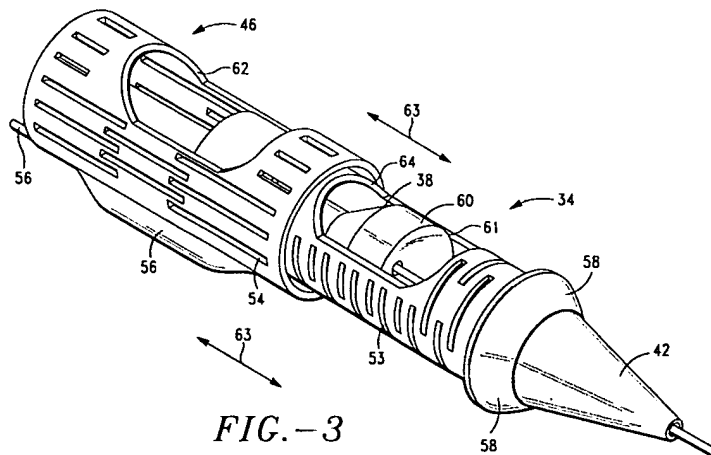
3) In regards to anticipation rejection of Claim 31, Claim 31 describes a shaft having an end and a blade at the end movable to extend out of the shaft to cut tissue when present outside of the instrument. There is no shaft out of which any blade is moveable, rather the scissors 18 which the Examiner contends is the Claim 31 blade extends apart from the endoscope 16 contended by the Examiner to be the Claim 31 shaft. This is clearly evident from above FIG. 1 of Ginn which relies on two different shafts one for endoscope 16 and the other for scissors 18. Thus, Claim 31 also cannot be anticipated by Ginn as each any every element of Claim 31 is not found in Ginn.

4) Claims 4-5, 8-10, 20-24, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginn in view of U.S. Patent No. 6,036,707 (Spaulding).

a) First, Claims 4-5 and 10 depend on at least Claim 1, and Claim 29 depends on Claim 25. For reasons argued earlier, Claims 1 and 25 are patentable over Ginn. Spaulding also fails to describe or suggest Claims 1 and 25, for e.g., the Claim 1 guide tube is not suggested in Spaulding since its cutter 60 is not guided along an outer tubular surface of any guide tube, and Spaulding teaches the opposite with respect to the Claim 25 blade guiding member being non-movable with respect to the shaft of the instrument. Thus, along with Claims 1 and 25 their Claims 4-5, 10 and 29 are patentable over the combination of Ginn and Spaulding, and withdrawal of the rejection of Claims 4-5, 10 and 29 is requested.

b) Second, Claim 8 describes a blade shuttle extendable from or retractable back through an opening in the instrument's shaft. In Ginn, there is no shaft having any opening through which any blade or blade shuttle is extendable or retractable, rather the scissors 18 which the Examiner contends is the Claim 8 blade is apart from the endoscope 16 contended by the Examiner to be the Claim 8 shaft (see FIG. 1 above). Further, there is no guide tube in Ginn having an outer surface along which any blade or blade shuttle travels (see again FIG. 1 above).

The Examiner contends that Spaulding teaches a blade shuttle that travels along the outer surface of a guide tube in FIG. 3 of Spaulding (see page 5 of the 1/27/10 Office Action). However, the Examiner has erred as the below copied FIG. 3 of Spaulding shows the opposite of the Examiner's position:



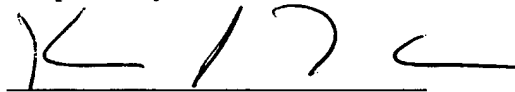
In the above figure neither work element 38, nor the cutter 60, of Spaulding can be the blade shuttle of Claim 8, since they do not ride along the outer tubular surface of any tube, and thus nothing in the combination with Ginn suggests moving its scissors 18 in a shuttle along any outer tubular surface of any tube. Rather Spaulding's work element 38 and its cutter 60 moves "within the housing 34". Moreover Ginn, like Spaulding, also teaches the opposite of Claim 8 by designing its scissors 18 to extend along an interior surface (of lumen 38) of Ginn's member 20. The Examiner contends to be the guide tube of Claim 8. Accordingly, the combination of Ginn and Spaulding cannot describe or suggest the blade shuttle or guide tube of Claim 8, or of Claims 9 and 20-24, and withdrawal of the 35 U.S.C. 103(a) rejection of Claims 8-9 and 20-24 is requested.

5) Claims 5 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginn, in view of Spaulding and U.S. Patent No. 5,562,694 (Sauer et al.) "Sauer". Claims 5 and 20 depend on at least one of Claims 1 and 8, which for reasons argued earlier are patentable over Ginn and Spaulding. As Sauer fails to describe or suggest that argued above as being absent in Ginn and Spaulding from Claims 1 and 8, Claims 5 and 20 cannot be obvious in view of the combination of Ginn, Spaulding, and Sauer, and withdrawal of the rejection of Claim 5 and 20 is requested.

In view of the above, the Application is clearly not ripe for appeal as the Examiner has not properly rejected each and every pending Claim of the Application. Accordingly, Applicant requests withdrawal of the final rejections.

Dated: May 27, 2010

Respectfully submitted,



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